

### REMARKS

In the Office Action, the Examiner rejected Claims 1-17, which are all of the pending claims, under 35 U.S.C. 101 as being directed to non-statutory subject matter, and under 35 U.S.C. 112, first paragraph, as not complying with the enablement requirement. None of the claims was rejected over the prior art.

In addition, although the Examiner considered Claims 16 and 17 on their merits, the Examiner also withdrew these claims due to a restriction requirement. More specifically, in this Restriction Requirement, the Examiner argued that the application includes claims directed to two separate and distinct inventions – Claims 1-15, and Claims 16 and 17. The Examiner further argued that since Applicant has received an action on the merits for Claims 1-15, these claims have been constructively elected for prosecution on the merits. Accordingly, the Examiner withdrew Claims 16 and 17 from consideration in this application.

In view of the fact that the merits of Claims 16 and 17 were considered in the Office Action, Applicants will also consider the merits of these claims in this response.

Claims 1, 2, 6, 7, 11, 12 and 16 are being amended to improve the form and readability of these claims. Also, Claim 10 is being amended to correct the dependency of this claim.

For the reasons set forth below, all of Claims 1-17 comply with the requirements of 35 U.S.C. 101 and 112, and the Examiner is thus asked to reconsider and to withdraw the rejections of Claims 1-17 under 35 U.S.C. 101 and 112, and to allow these claims.

Applicants will first address the rejection of the Claims under 35 U.S.C. 101 and then the rejection of the claims under 35 U.S.C. 112.

Rejection under 35 U.S.C. 101

With respect to the rejection of the claims under 35 U.S.C. 101, the Examiner raised the following specific objections:

1. the language of the claims raises a question as to whether the claims are directed merely to an abstract idea,
2. the claims are not supported by either a specific asserted utility or a well established utility,
3. the claims are directed merely to an abstract idea that would not result in a practical application, and
4. the claims mention merely the mathematical equation, and lack the software.

All of the claims are directed to practical and useful processes or systems. In particular, Claims 1-10 are directed to a method of, or a system for, measuring the size of a distributed system of interconnected computer servers. Claims 11-15 are directed to a software program for implementing method steps for measuring the size of a distributed system of interconnected computer servers. This is a very tangible and concrete result.

For example, given the very large size of some of today's computer systems, it is very useful to have some way to quantify the sizes of those systems in a way that can be used, for example, to assign manpower to the system. Because a large distributed system of servers may have many different specific types of servers with different capabilities, merely using the number of servers in the system as a measure of the system size may not be particularly helpful. The present invention, in contrast, may be used to provide a helpful, practical and useful measure of that size.

Moreover, each of the independent Claims 1, 6 and 11 set forth specific tangible, physical features. For instance, each of these claims describes a distributed system of interconnected computer servers, and these claims also set forth the CPUs and RAMs installed on the system, and describe details for using the count of CPUs and the RAM to determine a measure of the size of the distributed system. These claims do not describe merely an abstract idea, but instead set forth specific functions and features, and describe how those functions and features are used to achieve a specific, practical result – obtaining a measure of the size of the distributed computer system.

For analogous reasons, Claim 16 and Claim 17, which is dependent from Claim 1, also define statutory subject matter within the meaning of 35 U.S.C. 101. These claims are expressly directed to a method for measuring the size of a distributed system of interconnected computer servers. Again, this is a tangible, concrete result that, as mentioned above, is also practical and useful. In addition, Claim 16 positively sets forth a number of specific, tangible, physical features. For example, this claim describes the CPUs installed on the system, the RAM installed on the system, and the claim expressly sets forth a procedure for using these factors, and others, to determine the relative sizes of two servers, and the size of the distributed system of interconnected server.

In view of the above-discussion, Claims 1-17 are all directed to statutory subject matter within the meaning of 35 U.S.C. 101. The Examiner is, accordingly, asked to reconsider and to withdraw the rejection of Claims 1-17 under 35 U.S.C. 101.

#### Rejection of the Claims under 35 U.S.C. 112

In rejecting the claims under 35 U.S.C. 112, the Examiner argued that the claims are not enabling to make or use by either a specific substantial and credible asserted utility or a well

established utility for deriving a claimed subject method. Claim 10 was further rejected under 35 U.S.C. 112, first paragraph, on the grounds that one skilled in the art would not know how to use the claimed invention.

The specification fully enables those of ordinary skill in the art to practice the claimed inventions.

Claims 1-15 describe two functions, and how these functions are used to obtain a measure of the size of a distributed system of interconnected computer servers. The first of these functions is a function of the count of CPUs installed in each server, and the second function is a function of the amount of RAM installed on each server.

These two functions, the way they are used, and sample values are discussed in detail in the specification, from line 27 of page 7 to line 13 of page 8. There, the specific factors used in these functions and specific equations used to determine these functions are explained in detail, and specific sample values are expressly given. For example, it is explained that the first function includes a weighting factor  $w_c$  based on the central processing units installed on the system, and another factor  $e_c$  that is based on the system architecture and operating system. Also, it is clearly explained that the second function includes a weighting factor  $w_r$  that is based on the amount of RAM on the server, and another factor  $e_r$  that is also based on the system architecture and operating system. In addition, specific sample values for various factors, including  $w_c$  and  $w_r$ , are expressly set forth on page 7 of the specification.

Given this clear and detailed teaching, those of ordinary skill in the art would be able to practice the subject matters defined by Claims 1-15 to obtain a measure of the size of a distributed system of computer servers.

With particular regard to Claim 10, as mentioned above, this claim is being amended to be dependent from Claim 6, and Claim 10 has the same utility and usefulness as Claim 6 -- to obtain a measure of the size of a distributed system of interconnected servers. Claim 10 elaborates on a feature set forth in Claim 6, a normalizing factor representing a reference date. As described in Claim 10, this reference date is a base reference year for the RAM. This feature is discussed, and a specific example value for this normalizing factor, is provided on page 7 of the specification. In view of this discussion, the specification also fully enable the specific subject matter expressly set forth in Claim 10.

In light of the foregoing remarks, the specification fully enables the subject matters of Claims 1-15, and the Examiner is thus asked to reconsider and to withdraw the rejection of these claims under 35 U.S.C. 112.

Claims 16 also refers to the two functions discussed above in connection with Claims 1-15, and for the reasons advanced above, this aspect of Claim 16 is also fully enabled by the specification. In addition, Claim 16 describes steps for comparing two servers. This aspect of Claim 16 is discussed in detail in the specification from page 3, line 9 to page 6, line 7. In this portion of the specification, each factor -- including the Server Image Power Rating (SIPR), the Server Image Power Class (SIPC), and the server categories, are fully explained, with specific examples and specific sample values. This detailed explanation enables those of ordinary skill in the art to practice the steps set forth in Claim 16 for comparing the two servers.

Thus, the specification also fully enables Claim 16 and Claim 17, which, as mentioned above, is dependent from Claim 16, and the Examiner is requested to reconsider and to withdraw the rejection of Claims 16 and 17 under 35 U.S.C. 112.

In conclusion, for the reasons discussed above, Claims 1-17 fully comply with the requirements of 35 U.S.C. 101 and 112. The Examiner is, consequently, asked to reconsider and to withdraw the rejections of Claims 1-17 under 35 U.S.C. 101 and 112. As noted above, none of these claims was rejected over the prior art, and thus these claims are in condition for allowance, a notice of which is requested. If the Examiner believes that a telephone conference with Applicant's Attorneys would be advantageous to the disposition of this case, the Examiner is asked to telephone the undersigned.

Respectfully submitted,

*John S. Sensny*  
John S. Sensny  
Registration No. 28,757  
Attorney for Applicant

SCULLY, SCOTT, MURPHY & PRESSER  
400 Garden City Plaza – Suite 300  
Garden City, New York 11530  
(516) 742-4343

JSS:jy